2007-1091
(Serial No. 09/910,654)

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE RODGER BURROWS

Petition For Rehearing
From The Panel Decision Of The Court Of Appeals For The Federal Circuit Regarding The Appeal From The United States Patent And Trademark Office, And the Board Of Patent Appeals And Interferences

PETITION OF APPELLANT RODGER BURROWS

Richard M. Saccocio
Richard M. Saccocio, P.A.
780 W. Tropical Way
Plantation, FL 33317
(954)-764-8003

Attorney for Appellant
September 21, 2007

In re Burrows

No. 2007-1091

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Counsel for the Appellant certifies the following:

1. The full name of every party or amicus represented by me is Rodger Burrows

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: N/A

3. All parent corporations and any publicly held companies that own 10% or more of the stock of the party or amicus represented by me are: None

4. There is no such corporation listed in paragraph 3.

5. The name of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:
   Richard M. Saccocio, P.A.
   Richard M. Saccocio, Esq.

Date: 9/21/07

Signature of Counsel

Richard M. Saccocio
Printed Name

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THE POINTS OFLAW OR FACT OVERLOOKED OR MISAPREHENDED BY THE COURT

It is respectfully submitted that Decision of the panel hearing the appeal from the United States Patent and trademark Office, Board of Patent Appeals and Interferences has overlooked or misapprehended the requirements of Graham v. John Deere Co, 383 U.S. 1 (1966) and the subsequent cases of In re Greene, 1999 U.S. App. Lexis 32002 (Fed. Cir. 1999), In re Rouffet, 143 F.3d 1350 (Fed. Cir. 1998), and In re Hans Oetiker, 977 F.2d 1443 (Fed. Cir. 1992).

In John Deere, Co. supra, The U.S.Supreme Court mandated that a ruling on obviousness or nonobviousness must include: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."

But if the examination at the initial stage of patent examination does not produce a prima facie case of unpatentability, then without more the applicant is entitled to the grant of the patent, In re Hans Oetiker, 977 F.2d 1443 ((Fed. Cir. 1992). In the absence of a showing of a prima facie case of obviousness, an applicant is entitled to a patent, In re Rouffet, 149 F.3d 1350 (CAFC 1998). A prima facie case of obviousness is established when the teachings from the prior art

itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. The constituent factual findings for a prima facie case of obviousness are: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the prior art and the claimed invention, *In re Greene*, 1999 U.S. App Lexis 32002 (CAFC 1999).

In the present case, in rejecting Burrows' claims, neither the Patent Office nor the BPAI determined the scope and content of the prior art, did not determine the level of ordinary skill in the art and did not determined the differences as required by John Deere, Co supra and consequently did not follow the decisions in the cases of In re Hans Oetiker, 977 F.2d 1443 ((Fed. Cir. 1992). In the absence of a showing of a prima facie case of obviousness, an applicant is entitled to a patent, In re Rouffet, 149 F.3d 1350 (CAFC 1998).

The CAFC panel in affirming the rejection of Burrows' claims , without opinion, overlooked the facts in the present case as regards the rulings of above cited cases. The panel's opinion gives no insight as to how or why the above cases were not material to the rendering of obviousness of Burrows invention.

ARGUMENT

My name is Richard M. Saccocio. I am an adjunct at one of the local South Florida Law Schools. I teach Patent Law. Its a basic course. As my course continues, the students actually begin to enjoy the course. Maybe it's the subject; maybe it's the way I teach it; maybe it's me. Sometimes however, it is hard to reconcile my teaching of the law of patents with actual cases. The present case is one of those times.

Earlier in the course, my students and I had explored what is an invention with the initial notation that the Patent Act defines an invention as an invention under § 100. That aside, it was ultimately agreed that an invention must be new, novel and different (35 U.S.C. S 102). But, further exploration brought out that nothing is really new; rather, anything new is generally a combination of old elements put together in a new way to achieve a unique result. At this point, the students began to doubt my credibility. But then I put § 102 in the context that if some thing was done before, it simply makes sense that a patent granting an inventor a monopoly for an extended period of time, should not issue because he or she did not invent it. My credibility improved. Then one bright student (number 1) said "Wait a minute, we are here to learn what is patentable, after all isn't that

what patent law is all about. An inventor does not want to hear just the negative aspects of the patent process; he or she wants to know if the invention is patentable." My credibility went down. In order to rehabilitate myself as a patent law professor, I countered that the next assignment would reveal all. The next assignment being non-obviousness.

Today we are discussing non-obviousness, i.e. what makes an old combination of elements so new that it deserves to be patented under 35 U.S.C. § 103. The assigned cases were those prior to Graham v. John Deere Co. 383 U.S. 1 (1966), and the John Deere case itself.

I began the class with a somewhat detailed review and class discussion of the court decisions prior to John Deere, which of course included the various attempts by different courts to apply §103. We discussed that some courts, like the Patent Statute, held an invention was patentable under §103 if it was an invention. Other courts having held that an invention must possess synergy before it is patentable under §103. Still other courts having held that an invention must possess a flash of genius to be patentable under §103. And, other courts having held that an invention must produce unusual and surprising results, or must push back the frontiers of science.

One bright student (number 2) having obviously read the assigned cases said, " Wait a minute, all of these so called requirements under §103 are

completely subjective and encouraged forum shopping. "Exactly, said I, that is why §103 became known as the 'plaything of the judiciary'."

Another Bright Student (number 3) said, "Wait a minute, since the U. S. Supreme Court took matters in it's own hands in the John Deere case and changed all of that , why did we waste our time delving into ancient history".

In reply (and my chance to strike a pose as a true professor of law,) I said, "True, but it helps to understand the rationale behind the John Deere case, and as future attorneys, you will never have all of the facts on your side and where you don't you will need to argue rationale. And beside which, the facts will be different in every case and you will need to argue the rationale behind the John Deere case to support your argument."

Student number 3: "Hmm. OK."

The facts of the John Deere case were discussed, the issues framed, and the court opinion analyzed. According to John Deere, a new and objective test was mandated for all future courts encountering the issue of obviousness under 35 U.S.C. § 103, to wit: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.. Against this background, the obviousness or nonobviousness of the subject matter is determined."

Student number 4: "Wait a minute, you say that the analysis for obviousness is now an objective test, yet we now have thee items, each of which must be evaluated for each case. It seems to me that a court could put a different spin on each of the three factors in order to reach an arbitrary conclusion. How is that objective?"

My reply: "Hmm." Ok, let's have a show of hands for those of you who believe that the invention in the John Deere case was not obvious."

About 50 % of the student body raised their hands.

Student number 4: " See what I mean."

My reply: "Hmm. At any rate let's look more closely at the three factors. I believe that if any one of the factors is missing, then there must be a ruling of non-obviousness. Do you agree with this premise?"

The Student Body: A number of skeptical expressions appear.

My reply, "Look, if the U.S. Supreme Court un-equivocally states that each of the three factors must be met before a finding of obviousness or nonobviousness exists, then it follows that the invention is not obvious, correct?

Various students: "Phrased that way, that is a logical conclusion."

My Reply: "Actually, my phrasing is just another way of stating the a prima facie case of obviousness or nonobviousness exists only if all three factors are met and if one or more of the factors are not met, then a prima facie case of

obviousness or nonobviousness does not exist. I refer you to the cases of In re Greene, 1999 U.S. App. Lexis 32002 (CAFC 1999), In re Rouffet, 143 F.3d 1350 (CAFC 1998), and In re Hans Oetiker, 977 F.2d 1443 (CAFC 1992)"

I further stated that, "Each of these three cases and in fact all subsequent cases determined by the Court of Appeals for the Federal Circuit have unaminously held that if any one of the three factors is missing from the rejection by the Patent Office , then a prima facie case of nonobviousness is missing and not shown and the patent must be granted."

Student number 5, "Wait a minute, let's go back to your case before the CAFC, In re Burrows. Without repeating all of your arguments, it is most obvious that not one of the three factors required per John Deere was shown or even alluded to by the Patent Office and even the BPAI, how then can you say that the test under § 103 is objective?"

I said, "I don't say. That was my continuing argument before the Patent Office, and the BPAI. Let's face it, neither the Patent office nor the BPAI made the three step analysis per John Deere."

Student number 6, "Wait a minute, are you teaching that John Deere is the absolute law regarding obviousness and neither the Patent Office nor the BPAI made a showing in accordance with John Deere and yet rejected the claims in the Burrows application and yet the CAFC held it was not clearly erroneous?"

I said, "Unfortunately, that is the situation."

Student number 7, "Something is wrong here, or I am missing what you are teaching."

Student number 8, "Wait a minute, you appealed to the CAFC, surely, that court has to follow its own decisions subsequent to John Deere."

I said, "You have to understand, the CAFC affirmed without a written opinion, so we don't know the basis of the affirmation by the CAFC."

Student number 9, "Come on Professor, you are not that naive."

Student number 10, "I don't believe this. You have not told us all of the facts."

Student number 11, "I believe it, but I don't understand it."

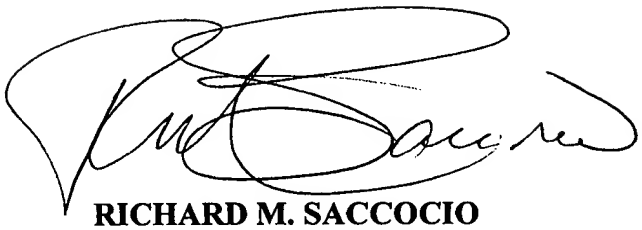
Student number 12, "As a matter or legal responsibility to your client, surely you intend to not let the decision as it now exists to lie?"

I said, "No. My duty as a lawyer and to my client requires that I go at least one step further."

Student number 13, "Right, you can request a rehearing."

I said, "That is exactly what I am now doing."

Respectfully submitted,



RICHARD M. SACCOCIO
780 W. TROPICAL WAY
PLANTATION, FL 33317
(954) 764-8003
E-MAIL: rmsaccocio@bellsouth.net

ADDEMDUM

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

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IN RE RODGER BURROWS

Judgment

ON APPEAL from the **UNITED STATES PATENT AND TRADEMARK OFFICE, BOARD OF PATENT APPEALS AND INTERFERENCES**

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam (RADER, SCHALL, Circuit Judges, FARNAN, JR., District Judge[1]).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

DATED: August 9, 2007

/s/ Jan Horbaly
Jan Horbaly, Clerk

[1] Honorable Joseph J. Farnan, Jr., District Judge, United States District Court for the District of Delaware, sitting by designation.

CERTIFICATE OF COMPLIANCE

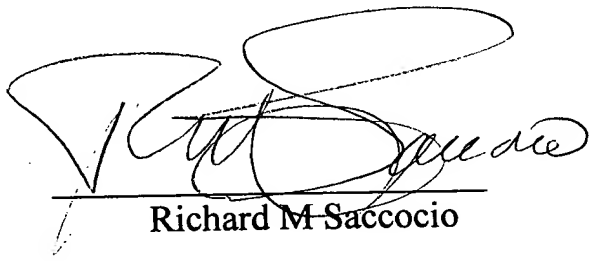
Pursuant to Federal Circuit Rule 28(a)(14) and federal rule of Appellate Procedure 31(a)(7)(c), counsel for Amicus Curiae hereby certifies that the foregoing brief of Amicus Curiae complies with the type-volume limitation prescribed in Federal rule of Appellate Procedure 28(a)(7) (B)(i) and was prepared using the following:

Microsoft Word 2003

Times New Roman

14 Point Typeface

Counsel relied on the word count function of Microsoft Word 2003 which indicates a total of 1429 words exclusive of the sections not included in the word count as per the Federal Circuit Rules.



Richard M Saccocio

CERTIFICATE OF FILING AND SERVICE

I hereby certify that on the 21st day of September, 2007, I mailed the original and eleven copies of the foregoing Petition For rehearing to the Clerk's Office of the Court of Appeals for the Federal Circuit via U.S. Express Mail, and further that I served two copies of said petition on,

U.S. Patent and Trademark Office
Office of the Solicitor
P.O. Box 15667
Arlington VA 22215
Attention: Nathan Kelley, Esq.

on said date via U.S. First Class Mail.

RICHARD M. SACCOCIO
780 W. TROPICAL WAY
PLANTATION, FL 33317
(954) 764-8003
E-MAIL: rmsaccocio@bellsouth.net